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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GOLD, AVI M	

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/911,799	ENETE ET AL.	
	Examiner	Art Unit	
	Avi Gold	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/7/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment received on February 7, 2005 has been entered and fully considered.

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 8, 10-15, 20, 21, 23, 24, 26-29, and 32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by DeSimone et al., U.S. Patent No. 6,212,548.

DeSimone teaches the invention as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract).

Regarding claims 1, 20, and 21, DeSimone teaches a communications method, a communications apparatus, and a computer program, comprising:

enabling instant messaging communication between a sender and at least one recipient through an instant messaging host according to an instant messaging protocol (col. 1, lines 25-33, col. 4, lines 24-29, DeSimone discloses Internet Relay Chat with a protocol); and

receiving, at the instant messaging host according to a protocol for transferring video instant messages, a video instant message directed to the at least one recipient after recording of the video instant message has been completed by the sender (col. 1, lines 45-47, col. 15, lines 58-63, DeSimone discloses video communication through chat and the video sent as an attachment which would be completed by the sender); and

sending, according to the protocol for transferring video instant messages, the video instant message from the instant messaging host to the at least one recipient for playback (col. 5, lines 25-32, DeSimone discloses an instant message being sent from a sender to multiple recipients).

Regarding claim 2, DeSimone teaches the method of claim 1 further comprising receiving and authenticating a text instant from the sender at the instant messaging host (col. 5, lines 35-43, DeSimone discloses a unique identifier associated with a user).

Regarding claim 3, DeSimone teaches the method of claim 2 wherein authenticating comprises identifying a screen name associated with at least one of the sender and the recipient (col. 5, lines 44-45, DeSimone discloses a chat nickname).

Regarding claim 4, DeSimone teaches the method of claim 3 wherein authenticating comprises identifying an IP address associated with at least one of the sender and the recipient (col. 5, lines 44-45, DeSimone discloses an IP address associated with a user).

Regarding claim 5, DeSimone teaches the method of claim 1 further comprising determining capabilities of the recipient at the instant messaging host (col. 5, lines 16-21, DeSimone discloses servers that have message handling information of recipients).

Regarding claim 8, DeSimone teaches the method of claim 5 further comprising reporting the capabilities of the recipient to the sender (col. 5, lines 16-21).

Regarding claim 10, DeSimone teaches the method of claim 1 further comprising receiving, at the instant messaging host, a request to establish video communication (col. 5, lines 46-48, col. 15, lines 58-63, DeSimone discloses conversations initiated by the sender and video messages).

Regarding claim 11, DeSimone teaches the method of claim 10 wherein the request is from the sender (col. 5, lines 46-48).

Regarding claim 12, DeSimone teaches the method of claim 10 wherein the request is from the recipient (col. 5, lines 55-58, DeSimone discloses that any participant can make requests).

Regarding claim 13, DeSimone teaches the method of claim 10 further comprising authenticating the request (col. 5, lines 35-43).

Regarding claim 14, DeSimone teaches the method of claim 13 wherein authenticating comprises identifying a screen name associated with at least one of the sender and the recipient (col. 5, lines 44-45).

Regarding claim 15, DeSimone teaches the method of claim 13 wherein authenticating comprises identifying an IP address associated with at least one of the sender and the recipient (col. 5, lines 44-45).

Regarding claim 23, DeSimone teaches the computer program of claim 21, wherein the computer readable medium comprises a client device (col. 1, lines 25-33, DeSimone discloses software on a user terminal).

Regarding claim 24, DeSimone teaches the computer program of claim 21, wherein the computer readable medium comprises a host device (col. 1, lines 25-33, DeSimone discloses a chat room maintained on a chat server).

Regarding claim 26, DeSimone teaches the method of claim 1 further comprising authenticating the video instant message (col. 5, lines 35-43).

Regarding claim 27, DeSimone teaches the method of claim 26 wherein authenticating comprises identifying a screen name associated with at least one of the sender and the recipient (col. 5, lines 44-45).

Regarding claim 28, DeSimone teaches the method of claim 27 wherein authenticating comprises identifying an IP address associated with at least one of the sender and the recipient (col. 5, lines 44-45).

Regarding claim 29, DeSimone teaches the method of claim 1 further comprising moderating an instant messaging session during which the video instant message is received and sent (col. 1, lines 45-47, col. 5, lines 25-32, col. 15, lines 58-63).

Regarding claims 32 and 35, DeSimone teaches a communications method and communications apparatus, comprising:

establishing an instant messaging communications session between a sender and a recipient through an instant messaging host according to an instant messaging protocol (col. 1, lines 25-33, col.4, lines 24-29); and

in the instant messaging communications session between the sender and the recipient:

receiving, according to a protocol for transferring video instant messages, a video instant message from the sender and forwarding the video instant message to the recipient (col. 1, lines 45-47, col. 15, lines 58-63); and

receiving, according to the protocol for transferring video instant messages, a reply video instant message from the recipient in response to the video instant message forwarded to the recipient from the sender (col. 1, lines 45-47, col. 13, lines 63-66, col. 15, lines 58-63, DeSimone discloses users being in a conversation which involves response);

wherein the video instant message and the reply video instant message are discrete communications (col. 15, lines 58-63).

Regarding claim 33, DeSimone teaches the method of claim 31 wherein the discrete communications are independent messages (col. 15, lines 58-63).

Regarding claim 34, DeSimone teaches the method of claim 31 wherein the discrete communications are discontinuous and self-contained messages (col. 15, lines 58-63).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone further in view of Doty, Jr., U.S. Patent No. 6,795,863.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract).

As to claims 6, 7, and 9, DeSimone teaches the method of claims 5 and 8.

DeSimone fails to teach the limitation further including the identifying hardware and software associated with the recipient and the sender displaying a user interface according to the capabilities of the recipient.

However, Doty, Jr. teaches a plurality of client recipient computers, wherein the video streams may be embedded into a web page that provides e-mail services, preferably over the Internet (see abstract). Doty, Jr. teaches the use of a recipient computer specifying its hardware and software capabilities (col. 8, lines 45-50) and a product distribution smart server basing its data stream format on recipient capabilities (col. 8, lines 54-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone in view of Doty, Jr. to identify hardware and software associated with the recipient and have the sender display a user interface according to the capabilities of the recipient. One would be motivated to do so because it would allow for the recipient to view the video communication at the best possible quality and to avoid errors in viewing.

5. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone further in view of Wan et al., U.S. Patent No. 6,529,475.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract).

As to claims 16-19, DeSimone teaches the method of claim 1.

DeSimone fails to teach the limitation further including the video communication comprising establishing a generic signaling interface channel, a control channel, and a video channel between the sender and the recipient.

However, Wan teaches a method and system for improving flow of data traffic within a multimedia communications network by reducing congestion (see abstract). Wan teaches the use of a signaling channel, control channel, and data channel through which video is sent and TCP for the video and control channel (col. 3, lines 24-30) and UDP for the video (col. 3, lines 38-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone in view of Wan to use a generic signaling interface channel, a control channel, and a video channel between the sender and the recipient. One would be motivated to do so because a UDP channel minimizes latency and a TCP channel is used to pass through firewalls that block UDP.

6. Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone further in view of Lamb et al., U.S. Patent No. 6,747,970.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract).

As to claims 22 and 25, DeSimone teaches the method of claim 21.

DeSimone fails to teach the limitation further including a computer readable medium comprising a disc and a propagated signal.

However, Lamb teaches a system and techniques providing advanced telecommunications services using connectionless network host(s) for service implementation while using connection-based network equipment for transport of at least a portion of a telecommunications session (see abstract). Lamb teaches the use of a disk and a propagated signal as computer readable mediums (col. 25, lines 11-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone in view of Lamb to use a computer readable medium

comprising a disc and a propagated signal. One would be motivated to do so because they are both useful and efficient computer readable mediums known in the art.

7. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone et al., U.S. Patent No. 6,212,548, further in view of Fukasawa et al., U.S. Patent No. 6,738,822.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract).

As to claims 30 and 31, DeSimone teaches a communications method and communications apparatus, comprising:

establishing an instant messaging communications session between a sender and a recipient through an instant messaging host according to an instant messaging protocol (col. 1, lines 25-33, col. 4, lines 24-29);

receiving, at an instant messaging client, an instant message that is directed from the sender to the recipient (col. 1, lines 45-47, col. 15, lines 58-63);

receiving, as a component part of the instant message, a discrete video instant message that has been recorded by the sender (col. 1, lines 45-47, col. 15, lines 58-63).

DeSimone fails to teach the limitation further including the receiving an indication from the user that triggers the sending of the video instant message after recording of the video instant message is completed by the sender.

However, Fukasawa teaches a relay apparatus, system and method, and storage medium (see abstract). Fukasawa teaches the use of the server session terminating when the video is done recording and notifying the video client of the completion (col. 14, lines 47-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone in view of Fukasawa to use a trigger to send the video after it is completed. One would be motivated to do so because it allows for the completed video to be automatically sent without extra, unnecessary steps from the user.

Response to Arguments

8. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,748,421 to Ozkan et al.

U.S. Pat. No. 6,677,976 to Parker et al.

U.S. Pat. No. 6,564,248 to Budge et al.

U.S. Pat. No. 5,956,716 to Kenner et al.

U.S. Pat. No. 5,793,365 to Tang et al.

U.S. Pat. No. 5,764,916 to Busey et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

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